IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant(s): Joachim Ungruh et al.
Appl. No.: 09/423,501
Conf. No.: 6814
Filed: November 8, 1999
Title: METHOD AND SYSTEM FOR ADMINISTERING PERFORMANCE FEATURES FOR TELEPHONE SUBSCRIBERS
Art Unit: 2642
Examiner: Hector A. Agdeppa
Docket No.: 112740-057

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APPELLANTS' APPEAL BRIEF

Sir:

Appellants submit this Appeal Brief in support of the Notice of Appeal filed on September 26, 2003. This Appeal is taken from the Final Rejection dated March 26, 2003.

I. REAL PARTY IN INTEREST

Siemens Aktiengesellschaft is the real party in interest of the above-identified patent application by virtue of an assignment executed in 1998 and recorded in the United States Patent and Trademark Office on Reel 010489, Frame 0063.

II. RELATED APPEALS AND INTERFERENCES

To the best of Appellant's knowledge, there are no pending appeals or interferences that will directly affect, have bearing on, or that will be directly affected by the Board's decision with respect to the above-identified Appeal.

III. STATUS OF CLAIMS

Claims 6-15 are pending in the application. A copy of the present claims is attached in the Appendix. Presently, claims 6-15 stand rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 6,031,904 to *An et al.* Additionally, claims 6-15 were rejected in the

alternative under 35 U.S.C. §103 (a) as being obvious over *An et al.* A copy of the Final Office Action and the prior art on which the rejection was based are included in the Supplemental Appendix as Exhibits 1 and 2, respectively.

IV. STATUS OF AMENDMENTS

The last Amendment considered by the Examiner was filed on December 31, 2002. No amendments were filed subsequent to the final Office Action.

V. SUMMARY OF INVENTION

The present application discloses a method and apparatus to administer performance feature for telephone subscribers that is less time consuming and more comfortable for the subscribers. In particular, the presently disclosed method and apparatus are particularly helpful for situations, for example, where the subscriber undertakes the administration of the performance features themselves (see page 2, lines 15-17).

In order to effect greater comfort and reduced time for a user to administer performance features, a first local telephone exchange LE1 includes a switching technology software VT (see FIG. 1 and page 3, lines 10-11 and 24-25). The first local telephone exchange LE1, as well as a second local telephone exchange LE2 is connected to a telephone network TN. (see page 3, lines 10-13). Telephone terminal equipment TLF and a computer TLPC associated with a subscriber are connected by a subscriber line to the first local exchange LE1. (See page 3, lines 11-13).

The second local exchange LE2 features a log-on node POP. The personal computer TLPC is provided with access to the internet via the telephone network TN and the log-on node POP. (See page 3, lines 15-17). Through the use of an internet browser, the subscriber may access and display data available over the internet. (See page 3, lines 17-19). The server is constructed such that the personal computer TLPC can communicate with the internet. This connection is enabled by equipping the server with a switching oriented application BTAS. (See page 4, lines 1-6).

Additionally, a second switching-oriented application VTALE affords a connection setup via the telephone network TN to the local exchange LE1 that can be recognized based on a telephone number and through which an inquiring telephone subscriber has their personal computer TLPC connected. (See page 5, lines 5-9). This second switching-oriented application

VTALE may communicate with the first telephone exchange LE1 by the use of signaling software, for example. (See page 5, lines 9-12).

With the above-described apparatus, a telephone subscriber may use an internet browser to provide a more user-friendly interface to communicate with a database TB in the subscriber's own telephone exchange (LE1, for example). (See page 5, lines 12-15). The switching-oriented application VTAS then affects data exchange from data terminal equipment PC at a service center O & M via the server WWW-S and converts for communication to the inquiring telephone subscriber. (See page 5, lines 15-19).

VI. ISSUES

A. Does U.S. Patent No. 6,031,904 to *An et al.* anticipate claims 6-15 under 35 USC §102(e) by disclosing each and every element of the claims?

B. Are claims 6-15 obvious under 35 U.S.C. §103(a) in view of U.S. Patent No. 6,031,904 to *An et al.*?

VII. GROUPING OF CLAIMS

Claims 6-15 stand or fall together.

VII. ARGUMENT

A. The rejection of claims 6-15 under 35 USC §102(e)

1.' <u>Legal Standards</u>

"The claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently described in a single prior art reference." *Verdegaal Bros v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ellipsis claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). *See also* MPEP § 2131.

Additionally, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a

given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ 2d 1949, 1950-51 (Fed. Cir. 1999). "In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Thus, the claims in the present application would be anticipated by U.S. Patent No. 6,031,904 to *An et al.* under 35 U.S.C. § 102(e) only if *An et al.* teaches each and every element of the claims and that inherent features be established by a basis in fact and/or technical reasoning to reasonably support determinations of inherency.

2. <u>U.S. Patent No. 6,031,904 to *An et al.* does not anticipate the claims because it does not disclose each and every element of the claims, either expressly or inherently.</u>

First regarding independent claim 6, *An et al.* does not teach or suggest all of the elements of the claimed method. In particular, claim 6 features "employing a telephone exchange containing a database pertaining to the performance features." In the final rejection, the Examiner has apparently equated the profile repository 18 shown in Figure 2 of *An et al.* and a service manager node 16 associated with the repository 18 as equivalent to the claimed "telephone exchange containing a database pertaining to the performance features." Rather, *An et al.* teaches service manager nodes 16 that, although they may form part of the PSTN 12, are not equivalent to the claimed "telephone exchange."

Even if the incorporation of the service manager node 16 into the PSTN could be characterized as equivalent to the claimed "telephone exchange", *An et al.* still fails to teach the claimed element of "effecting an internet connection between the data terminal equipment and an Internet server through the use of an Internet browser and a first switching-oriented application." The Examiner alleges that the feature of "switching-oriented applications" are either inherent or obvious "because such switching applications are essential for translating or converting web-based information into a language or communication understood by the switch" (i.e., switch 62 shown in the alternate example of Figure 3). This reasoning is defective in a number of ways.

First, the example of *An et al.* in Figure 3 only discloses an Internet connection between a service manager node 16 and a router 64 that forms part of the Internet 54. The actual Internet

access unit 58 through which subscribers are capable of connecting to the internet 54 are shown directly connected to the internet 54 in the example of Figure 3. Thus, it does not make sense to say that the claimed switching-oriented application is inherent or obvious in *An et al.* because the Internet connection between the actual data terminal equipment 58 and the internet server 54 is simply a direct IP link, which would vitiate any need for a switching application. The Examiner appears to be interchanging elements in order to try to make the rejection, rather than actually meeting the claim language where there is an Internet connection between the data terminal equipment and an Internet server (not an Internet connection between the telephone exchange and the data terminal equipment), which would be more analogous to the elements to which the Examiner is referring (i.e., a connection between the service manager node 16 equated with the claimed "telephone exchange" and an Internet server, which has been equated to web server 50 in the embodiment of Figure 2). Given this inconsistency, the reasoning of the rejection is also defective because the Examiner has failed to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from teaching the applied prior art as required for a proper application of inherency.

Another defect in the reasoning presented in the final rejection is the assertion that "the separation of a function or device into two or more functions or devices, as well as where the claimed device or functionality is located does not make for patentability" (See page 4, lines 3-6 of the final Office Action). Without commenting on the veracity of this *ad hoc* statement of the ostensible law concerning patentability, this statement more importantly evinces an expedient glossing over of the claimed elements in order to avoid having to substantively consider each element of the claim. The claimed first and second switching-oriented applications are not the separation of a singular function into two functions based on some arbitrary design choice. Rather, the first switching-oriented application helps to accomplish an Internet connection from data terminal equipment and an Internet server using Internet browsing, whereas the second switching-oriented application effects a telecommunications connection between the Internet server and a telephone exchange. These are separate functions that the Patent Office must consider when making a rejection. *An et al.* and the knowledge in the art contain no teaching or suggestion to include both of these functions. Indeed, *An et al.* teaches that t

Moreover, *An et al.* fails to teach or suggest the element of "effecting a telecommunications connection between the Internet server and the telephone exchange by using a second switching-oriented application which communicates with the first switching-oriented application, wherein communication between the data terminal equipment and the telephone exchange is ultimately established for the administration of the performance features." Rather, neither of the examples relied upon by the Examiner in Figures 2 or 3 disclose this feature. In particular, the example of Figure 3 actually effects an Internet connection between the Internet server 54 and the "telephone exchange", which has been equated with the disclosed service manager node 16. Furthermore, even if this Internet connection could be broadly characterized as a "telecommunications connection" (although such characterization would run afoul of proper claim interpretation since claim 6 already features a distinguishable "Internet connection") this connection is not effected using a second switching-oriented application, which would communicate with a first switching-oriented application.

Moreover, the example disclosed by *An et al.* in Figure 2 also fails to teach or suggest the claimed element because the communication between the web server 52 and the service manager node 16 is simply accomplished over a link 56 that is part of a private telephone company network, as an example (see column 4, lines 44-47). No teaching or suggestion is given that this link 56 would require a second switching-oriented application that also communicates with a first switching-oriented application. Indeed, no teaching or suggestion is given in the reference or in the knowledge commonly known in the art that this link would require any switching-oriented application.

Accordingly, in light of the foregoing, claim 6 is not anticipated, either directly or inherently, by the teachings of *An et al.* Furthermore, claims 7 through 10, which depend from claim 6, are allowable over *An et al.* for the same reasons. Accordingly, the Appellants ask that this rejection be reversed.

Additionally, with respect to apparatus claim 11, which has structural elements that correspond to the elements of method claim 6, this claim is allowable over *An et al.* at least for the reasons presented above with respect to claim 6. Additionally, claims 12-15, which depend

from claim 11, are also allowable over *An et al.* at least for the same reasons. Accordingly, the Appellants ask that this rejection be reversed.

B. The rejection of claims 5-16 Under 35 U.S.C. §103

1. Legal Standards

35 U.S.C. §103(a) states that:

> A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art were such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

In making a determination that an invention is obvious, the Patent Office has the initial burden of establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S. P.Q. 2d 1955, 1956 (Fed. Cir. 1993). "If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 U.S.P.Q. 2d 1443, 1444 (Fed. Cir. 1992). The Court of Appeals for the Federal Circuit has stated that the foundation facts for a *prima facie* case of obviousness are:

> (1) the scope and content of the prior art; (2) the difference between the prior art and the claimed invention; and (3) the level of ordinary skill in the art...Moreover, objective indicia such as commercial success and long felt need are relevant to the determination of obviousness....Thus, each obviousness determination rests on its own facts.

In re Mayne, 41 U.S.P.Q. 2d 1451, 1453 (Fed. Cir. 1997).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 837 F.2d 1071, 5, USPQ 2d 1596 (Fed. Cir. 1988). Second there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ, 580 (CCPA 1974).

In the present case, the Patent Office has failed to establish a *prima facie* case of obviousness because the cited reference nonetheless fails to teach or suggest every element of the claimed invention and because there is no teaching or suggestion within the reference cited or within the general knowledge of those skilled in the art that would have led one skilled in the art to make the modifications suggested.

2. There is no teaching or suggestion in the reference itself or within the art that would have lead one of ordinary skill in the art to determine that *An et al.* makes the elements of claims 6-15 obvious and the reference fails to teach or suggest every element of the claims.

As to the § 103(a) rejection in view of *An et al.*, the reference does not teach all of the elements, as discussed previously with respect to the rejection under §102(e). Additionally, the final Office Action has not established sufficient teaching or suggestion, either from itself or from the knowledge in the art that would motivate one of ordinary skill in the art to arrive at the claimed elements. In particular, the rejection merely states that the teachings of the first and second switching-oriented applications are obvious in *An et al.*, without giving any motivation why one of ordinary skill in the art would include these two, distinct applications in the disclosed system of the reference. The Appellants submit that a motivation cannot be found because, as argued previously in this brief, the system of *An et al.* would not need a first switching-oriented application for effecting communication between an Internet connection between data terminal equipment (e.g., the Internet Access Unit 58) and an Internet Server (50). In the case of Fig. 3 of *An et al,* the terminal equipment connects directly to the Internet, so the addition of a switching application would be unnecessary. Furthermore, in the example of Fig. 2 of *An et al.*, the Internet Access Unit 58 connects to the Internet through the PSTN and a provider 60. Again in this example, no first switching-oriented application is used or needed to effect an Internet connection.

Accordingly, in light of the foregoing, claim 6 obvious in light of the teachings of *An et al.* or the knowledge in the relevant art. Furthermore, claims 7 through 10, which depend from claim 6, are allowable over *An et al.* for the same reasons. Accordingly, the Appellants ask that this rejection be reversed. Additionally, with respect to claim 11, which has structural elements that correspond to the elements of method claim 6, this claim is allowable over *An et al.* at least

for the reasons presented above with respect to claim 6. Additionally, claims 12-15, which depend from claim 11, are also allowable over *An et al.* at least for the same reasons. Accordingly, the Appellants ask that this rejection be reversed.
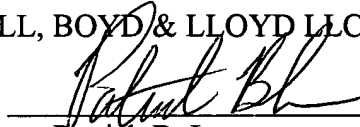
CONCLUSION

U.S. Patent No. 6,031,094 to *An et al.* does not disclose every element of claims 6-15. Further, *An et al.* and the knowledge in the art fail to suggest modification of the reference to make obvious the elements of claims 6-15. For these reasons, the Appellants respectfully submit that the rejections of claims 6-15 are an error in law and in fact and should, therefore, be reversed by this board.

Respectfully submitted,

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APPENDIX

Claim 6. A method for administering performance features for a telephone subscriber, the method comprising the steps of:

providing data terminal equipment with a display at a location undertaking the administration of the performance features;

employing a telephone exchange containing a data base pertaining to the performance features;

effecting an Internet connection between the data terminal equipment and an Internet server through the use of an Internet browser and a first switching-oriented application; and

effecting a telecommunications connection between the Internet server and the telephone exchange by using a second switching-oriented application which communicates with the first switching-oriented application, wherein communication between the data terminal equipment and the telephone exchange is ultimately established for the administration of the performance features.

Claim 7. A method for administering performance features for a telephone subscriber as claimed in claim 6, wherein the administration of the performance features proceeds from a personal computer of the telephone subscriber.

Claim 8. A method for administering performance features for a telephone subscriber as claimed in claim 6, wherein the administration of the performance features proceeds from a service center personal computer.

Claim 9. A method for administering performance features for a telephone subscriber as claimed in claim 6, wherein access of the data terminal equipment to the Internet occurs via a telephone network.

Claim 10. A method for administering performance features for a telephone subscriber as claimed in claim 6, wherein access of the data terminal equipment to the Internet occurs via a data line connection.

Claim 11. A system for administering performance features for a telephone subscriber, comprising:

data terminal equipment with a display at a location undertaking the administration of the performance features;

a first telephone exchange containing a data base pertaining to the performance features;

an Internet connection connecting the data terminal equipment to an Internet server through the use of an Internet browser;

a telecommunications connection connecting the Internet server to the first telephone exchange, wherein communication between the data terminal equipment and the first telephone exchange is ultimately established for the administration of the performance features; and

a second telephone exchange containing both a node for the Internet and a switching technology apparatus, wherein the Internet server is a component part of the node, and wherein the second telephone exchange further contains a first switching-oriented application that allows the Internet server to communicate with the data terminal equipment via the Internet connection and a second switching-oriented application that allows the Internet server to communicate with the first telephone exchange via the telecommunications connection, and wherein the first switching-oriented application communicates with the second switching-oriented application.

Claim 12. A system for administering performance features for a telephone subscriber as claimed in claim 11, wherein the data terminal equipment is a personal computer o the telephone subscriber.

Claim 13. A system for administering performance features for a telephone subscriber as claimed in claim 11, wherein the data terminal equipment is a service center personal computer.

Claim 14.   A system for administering performance features for a telephone subscriber as claimed in claim 11, wherein the telecommunications connection is effected by a telephone network, and wherein access of the data terminal equipment to the Internet occurs via the telephone network.

Claim 15.   A system for administering performance features for a telephone subscriber as claimed in claim 11, wherein the telecommunication connection is effected by a data line connection, and wherein access of the data terminal equipment to the Internet occurs via the data line connection.

SUPPLEMENTAL APPENDIX

Exhibit 1: Copy of Final Office Action dated March 26, 2003.

Exhibit 2: Copy of U.S. Patent No. 6,031,904 *An et al.*